



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,308	11/13/2001	Keizo Yamanaka	54888US006	8396

32692 7590 01/21/2004

3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE - 3 - MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 11/4/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicants have failed to respond to the Examiner's request for an Abstract of the Disclosure as required by 37 CFR 1.72(b). Accordingly, an Abstract on a separate sheet is required, as the Examiner repeats his request previously set forth in paragraph No. 1 of the initial Office action.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, applicants' disclosure at page 11, lines 10-16 where it teaches that although polytetrafluoroethylene is not preferred in the present invention a "modified polytetrafluoroethylene which is improved in the decaying property may be suitably used" and is followed by other embodiments involving mixtures of polymeric compositions is

Art Unit 1771

believed to be so vague and indefinite as to constitute an invitation to experiment since no parameters are set forth for one of ordinary skill to know what might be the metes and bounds of the claimed invention.

5. Claims 1-18 are rejected under 35 U.S.C. § 112, first paragraph as being based upon a non-enabling disclosure.

6. Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP -613 taken in view of applicants' admissions set forth at page 11, lines 10-16, particularly lines 12-13 of the specification. To somewhat partially reiterate, JP -613 clearly discloses the preparation of a pressure sensitive adhesive coated onto a suitable backing such as tetrafluoroethylene which is irradiated with a suitable ionization radiation beam, thereby improving the anchoring force of the adhesive agent relative to the substrate material. Although applicants argue that tetrafluoroethylene is, while a fluorine containing material, it decays when irradiated with an electron beam. However, the Examiner relies upon the aforementioned admission of applicant that a modified polytetrafluoroethylene which is <sup>im</sup>proved in the decaying property" may be suitably used, which is believed to be well within the ordinary skill of the art. As evidence of the state of the art, the Examiner cites Machi et al., U.S. 4,129,617, which discloses (note particularly the Abstract, column 1 line 65

Art Unit 1771

- column 2 line 17, column 3 lines 35-65, and column 5 lines 7-25) that polymers such as <sup>fluoropolymers which</sup> comprise a backbone chain of a fluoropolymer having side chains grafted thereon exhibit improved adhesion properties. Additionally, a wide variety of fluoropolymers are believed to be suitable (note, e.g. column 1 line 65 - column 2 line 17). Accordingly, one of ordinary skill, motivated by the desire to not have the fluorine containing sheet be decayed by exposure to radiation would modify the sheet in the manner suggested by Machi et al. and thereby either form, or clearly render obvious, the claimed genus of embodiments. What other parameters that are not either expressly or inherently disclosed are again each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Serial No. 10/009,308

-5-

Art Unit 1771

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

Dzirker:cdc

January 7, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zinker*